



Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450,

on October 25, 2004 (Date of Deposit).
10/25/04 [Signature]
Date Name

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No.: 04-892; formerly 16721-0210)

In re Application of:)
Salaun et al.) Confirmation No. 8956
)
Serial No.: 10/630,374) Before the Examiner:
) Kevin E. Weddington
Filed: July 30, 2003)
)
For: Novel Medicinal Product) Art Unit: 1614
)

SUPPLEMENTAL RESPONSE TO THE RESTRICTION REQUIREMENT
MAILED AUGUST 23, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Restriction Requirement mailed August 23, 2004, the Applicants provisionally elect the claims of Group II, i.e., claims 5-8, for prosecution. This election is made with traverse.

Applicants respectfully submit that the all the claims of the application should be searched as a whole. Applicants note that all 15 claims pending in this application are classified in class 514 and subclass 560. Clearly, searching all 15 claims simultaneously would not be unduly burdensome. Thus, Applicants

Serial No. 10/630,374
Filed: July 30, 2003
Examiner: Kevin E. Weddington
Group Art Unit: 1614

respectfully request that all 15 claims be combined into a single group for searching.

Further, even if the Patent Office maintains the position that there are multiple groups and that restriction is appropriate in this application, Applicants submit that the claims of Group IV, i.e., claims 10-13, are properly searchable with Group II. Claims 10-13 do not represent a different invention than those of Group II and should therefore be searched together with Group II. The claims of those two groups are directed to essentially the same invention: inhibiting differentiation of a fibroblast to an adipocyte using a 12-HETE or 11, 12-EET. The minor differences between these two sets are that (1) the HETE and EET are characterized as being arachidonic oxidation cascade metabolites in claim 10 and (2) claim 10 requires specific HETE stereoisomers. Thus, claims 5 and 10 are directed to the essentially the same invention.

Contrary to what is suggested in the Restriction at page 2, Claim 10 does not include the phrase "such as" which would indicate that HETE and EET are included merely as examples of arachidonic acid metabolites. As claim 10 is written, HETE and EET limit the scope of the phrase "arachidonic oxidation cascade

Serial No. 10/630,374
Filed: July 30, 2003
Examiner: Kevin E. Weddington
Group Art Unit: 1614

metabolite." The result is that claims 5 and 10 are directed to the same invention and should be searched simultaneously.

Allowance of claims and passage of the application to issue are respectfully requested. Applicants urge the Examiner to contact the Applicants' undersigned representative as (312) 913-0001 if the Examiner believes that this would expedite prosecution of this application.

Respectfully submitted,

Dated: October 25, 2004

By: _____

Steven J. Sarussi
Reg. No. 32,784

McDonnell Boehnen
Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606
(312) 913-0001